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IP

DOCKET NO.: CSAC-0009

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Ramesh, et al

Application No.: 09/782,337

Filing Date: February 13, 2001

For: Polyolefin Film/Foam/Film Composite Materials And Methods For Producing
Same

Confirmation No.: 9820

Group Art Unit: 1771

Examiner: Victor S. Chang

EXPRESS MAIL LABEL NO: EV 631244980 US
DATE OF DEPOSIT: May 2, 2006

EV631244980US

MS Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF PURSUANT TO 37 CFR § 1.193

Transmitted herewith in triplicate is the REPLY BRIEF in this application with respect to the Examiner's Answer dated **March 3, 2006**.

If any fee is required, please charge Deposit Account No. 23-3050. A duplicate of this transmittal is attached.

Date: May 2, 2006

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Sir:

APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Appellants submit this Reply in response to the Examiner's Answer dated March 3, 2006 in connection with the above-identified application. This reply is being filed within two months of said answer.

STATUS OF CLAIMS

Claims 1-7, 9, 10, 13-16, 18, 19, 22, 23, and 29-31 are pending and are rejected under 35 U.S.C. § 103(a) as allegedly obvious from U.S. Patent No. 4,469,741 (“the Akao patent”) in view of U.S. Patent No. 5,968,630 (“the Foster patent”). Claim 24 was withdrawn subject to a restriction requirement. The rejection of claims 1-7, 9, 10, 13-16, 18, 19, 22, 23, and 29-31 is appealed.

GROUNDΣ OF REJECTION TO BE REVIEWED ON APPEAL

Whether the Examiner has demonstrated that the subject matter of claims 1-7, 9, 10, 13-16, 18, 19, 22, 23, and 29-31 would have been obvious to those of ordinary skill in the art over U.S. Patent No. 4,469,741 (“the Akao patent”) and U.S. Patent No. 5,968,630 (“the Foster patent”).

ARGUMENTS

The claims on appeal are directed to a composite flooring material consisting essentially of a polyolefin foam sheet, a first polyolefin film heat-laminated to a first surface of the foam sheet, and a second polyolefin film heat-laminated to a second surface of the foam sheet (page 3, lines 12-14), where at least one edge of the second film extends beyond a corresponding edge of the foam sheet (page 3, lines 14-15). The Akao patent uses adhesive layers to bond films to a foam sheet (see, for example, Figure 2; column 2, lines 10-17; column 2, lines 34-40; and Example 1 spanning columns 4-5). Thus, one significant difference between the instantly claimed invention and the disclosure of the Akao patent is the presence of the adhesive layer in the constructions of the Akao patent.¹

In the Answer, the Examiner has taken the position, that if low density polyethylene is used as the adhesive and low density polyethylene is used as the film in the practice of the Akao patent, then upon cooling, the adhesive and polyethylene film will lose their individual identities and become a single layer (see the paragraph bridging pages 8-9 of the Examiner's Answer). The Examiner's position is not well taken. The Examiner is improperly "picking and choosing" among the reference's teachings to arrive at the claimed invention. The complete list of materials provided by Akao is extensive and does not motivate the selection of any particular combination of adhesives and film material that would lead to the claimed invention. Numerous films, for example, are discussed at column 2, lines 41-54 of the Akao patent. In addition, a number of adhesives are discussed at column 3, lines 1-9 of the Akao patent. No teaching is found that suggests that the film and the adhesive should be identical materials. Indeed, the examples of the Akao patent utilize a low density polyethylene adhesive and a high density polyethylene film (see, column 4, line 30 to column 5, line 46). Such picking and choosing, without any apparent motivation, is inconsistent with obviousness.

The Examiner's position should be rejected for the additional reason that no evidence is presented to support the contention that the film and adhesive layers of the Akao patent – *if* they were chosen to be the same material in the first place – would necessarily lose their individual identities. To arrive at a construction where the layers are not distinct, one would

¹ In our Appeal Brief (page 5) we discussed that because claim 1 uses "consisting essentially of" as the transition phrase, the claim does not permit an additional independent layer, such as the adhesive layer, to be utilized in the instant invention. Moreover, the recitation in the claim that the polyolefin films be "heat-laminated" to the underlying foam is a limitation that is not disclosed in Akao and that excludes, as necessarily redundant, the presence of an adhesive layer to effect the manufacture of the composite.

have to select process conditions that would allow for complete integration of the film and adhesive layer. No guidance is presented in the Akao patent for such a process, nor is there any suggestion that such a result could be expected.

Additionally, one skilled in the art would not necessarily believe that a polyethylene adhesive, for example, would contain the same ingredients as are found in a polyethylene film. A polyethylene adhesive, for example, might use additives to improve adhesion properties. Thus, absent extreme conditions, the adhesive and the film would retain a difference in composition even as they are bonded at the surface.

In view of the foregoing, even if one were to combine the teachings of the Akao patent (U.S. Patent No. 4,469,741) with the teaching of the Foster patent (U.S. Patent No. 5,968,630) as alleged by the Examiner, one would not arrive at any instantly claimed invention.

Applicants request that this patent application be remanded to the Examiner with an instruction to both withdraw the rejection for alleged unpatentability and allow the appealed claims.

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